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MAY 16 2006

OFFICE OF PETITIONS

In re Application of
Tognazzini
Application No. 08/655,136
Filing Date: May 30, 1996
Attorney Docket No.: 06202.0435
For: CATALOG PHONE SALES TERMINAL

Decision on Petition for
Patent Term Extension

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Pre-grant Application For Patent Term Adjustment," received on December 29, 2005.

The petition is GRANTED.

Petitioner notes that the Notice of Allowance dated October 12, 2005, in the above-identified application incorrectly stated that the patent term extension was 381 days. Petitioner argues that applicant is entitled to 1569 days of patent term extension, not the 381 days of extension as stated in the Notice of Allowance.

35 U.S.C. § 154(b) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for those delays and others in applications filed on or after May 29, 2000

A first Notice of Appeal was filed in the above-identified application on November 25, 1998. On August 30, 2002, the Board of Appeals and Interferences reversed the decision of the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in a reversal of an adverse decision of patentability, the patent to issue from the application is entitled to an extension of the patent term. The period of delay in the above-identified application is the period beginning on November 25, 1998, the date that the Notice of Appeal was filed and ending on August 30, 2002, the date of the final decision in favor of the applicant. Three years after the earliest effective filing date of the application is May 30, 1999. Accordingly, the period of extension is required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three

years after the filing date of the application. As a result, the first period of extension is 1,189 days, the period from May 30, 1999 to August 30, 2002, including the beginning and end dates.

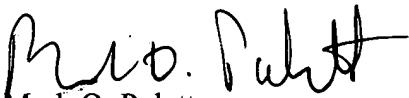
A second Notice of Appeal was filed in the above-identified application on June 15, 2004. On June 30, 2005, the Board of Appeals and Interferences affirmed-in-part the decision of the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in a reversal of an adverse decision of patentability, the patent to issue from the application is entitled to an extension of the patent term. The period of delay in the above-identified application is the period beginning on June 15, 2004, the date that the Notice of Appeal was filed and ending on June 30, 2005, the date of the final decision in favor of the applicant. Three years after the earliest effective filing date of the application is May 30, 1999. Accordingly, the period of extension is not required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the filing date of the application. As a result, the second period of extension is 381 days, the period from June 14, 2004 to June 30, 2005, including the beginning and end dates.

As a result, the period of extension is **1,570** days, the period from May 30, 1999 to August 30, 2002, including the beginning and end dates and the period from June 14, 2004 to June 30, 2005, including the beginning and end dates.

After mailing of this decision, the above-identified application will be forwarded to Office of Publications for further processing. The patent, if issued, will include an indication that the patent term is extended by **1,570 days**.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). The Petition fee \$200 for the petition under 37 CFR 1.705(b) is not required for this petition under 37 CFR 1.181 and the fee has been refunded to petitioner's Deposit Account (06-0916).

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark O. Polutta

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Office of Patent Legal Administration

Office of the Deputy Commissioner

for Patent Examination Policy